



Customer No. 000042131

Docket No. 104.002

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

**In re Patent Application of:**

Eugene S. Pearlman

**SERIAL NO.:** 09/303,315

**Group Unit:**1631

**FILED:** April 30, 1999

**Ex:** Lori A. Clow

**FOR:** ALGORITHMIC TESTING IN LABORATORY MEDICINE

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**EXHIBIT 1**

**AFFIDAVIT OF RASHIDA A.KARMALI**

**Interview Record prepared by Rashida Karmali on July 19, 2005**

Interview Date July 19, 2005 at 11.00am

Examiner Lora Clow ("LC"), Primary Marjorie Moran ("MM"), Supervisor Ardin Marschel ("AM")

Rashida Karmali ("RAK")

RAK placed the telephone at 11.00am to 571-272-0718.

RAK explained that client Mr Wolfert had not arrived. However, Mr Wolfert had instructed that the interview take place on time.

Supervisor AM stated that they were willing to wait.

RAK replied that she would have preferred to have Mr Wolfert present but since he had instructed to proceed, they should do so and she would give a detailed account of the interview to Mr Wolfert.

AM- stated that before proceeding with the interview he wanted to clarify that the role of the examiners was to assist applicants so that their patents are issued.

RAK replied that she agreed and pointed out that it was her duty to her client to ensure that proper Examination was provided . She was willing to work together with the examiners to achieve that end.

AM asked Examiner LC to describe the recent rejection.

LC- Stated that she had maintained the rejection based on Armstrong prior art and the phrase “not allowing a technician to add unnecessary tests” in the amendment did not overcome Armstrong. Gone back to June 2004 Office action—

RAK stated in response that this amendment had been accepted in the Response filed to Office Action of June 2004. And the prior art, Armstrong had been withdrawn.

LC replied that she did withdraw Armstrong in her next Action and that was a mistake. She should not have done so.

RAK stated that her entire experience with the case had been frustrating because the prosecution had been done piecemeal and inconsistent. She had held a personal interview in March 2004 and thought that all issues had been resolved. She thought Armstrong had been withdrawn and now it is reinstated. She suggested that perhaps the case was being examined by the wrong group.

AM interjected and indicated that it was the right group –Bioinformatics. He had been an examiner for 16 years at the US Patent Office.

RAK asked for a solution and how to proceed? She explained that the Specification was written in 1999 when guidelines for bioinformatics applications were not provided specifically.

MM stated that in March 2004 personal interview , they had discussed that there was no prior art for Hepatitis claim and it was allowable.. Therefore, if claim 27 were combined with claim 1, that would be allowable.

RAK replied that the algorithm for Hepatitis----

MM interrupted and stated that it was not the algorithm for Hepatitis. She did not want any misunderstanding. It was the method for testing Hepatitis in claim 27 that she was referring to.

RAK offered to combine claim 1 and claim 27 and send it to Examiner Clow in draft form for review.

AM stated that RAK should make sure that she renumbered the subsection correctly in the amended claim. He asked Examiner Clow to provide her personal fax number.

RAK stated that such a solution would be satisfactory to her client. She indicated that the client would file CIPs for remaining tests.

AM stated that was not a good idea. Prior art in the field was abundant. In an effort to reduce cost of health care, there were several patents on methods to avoid unnecessary tests.

RAK responded that prior art could be overcome by improvements in methods to make the invention patentable. She explained that her Client is connected with HIP, and was best suited to introduce the technology to reduce medical costs, because HIP is an insurer of medical costs. Without having proprietary rights there was not much incentive to introduce the technology. Her client had intended to test in a specific Florida Health practice the value of its patented technology in reducing costs. Getting the first patent was a great incentive.

The interview ended.

I hereby declare that all statements made herein to my knowledge are true, and all statements made on information and beliefs are believed to be true; and further, that these statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application, and patent issuing thereon.

BY: Rashida A. Karmali

Rashida A. Karmali, JD., Ph.D, Reg No. 43,705

DATE: 10/24/2005